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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,409	07/03/2003	David J. Good	3023.PKG	4461

7590 10/06/2005
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EXAMINER

SCHATZ, CHRISTOPHER

ART UNIT PAPER NUMBER

1733

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,409

Applicant(s)

GOOD ET AL.

Examiner

Christopher T. Schatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, 12, 13, drawn to a hot melt adhesive, classified in class 525, various subclasses.
 - II. Claim 11, drawn to a method of sealing and/or forming, classified in class 493, subclass 51.
 - III. Claim 14, drawn to a process of bonding two substrates, classified in class 156, subclass 60.
 - IV. Claims 15 and 21, drawn to an apparatus, classified in class 118, various subclasses.
 - V. Claim 16-20, drawn to a method of manufacturing an adhesive, classified in class 523 various subclass .

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as applying the hot melt adhesive to a and substrate and bonding said substrate to a second substrate.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a method of forming and/or sealing.

Inventions I and IV are related as product and apparatus for applying the product. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed can be used with another and materially different product or (2) that the product as claimed can be used in another and materially different apparatus. In this case the apparatus as claimed can be used with another and materially different product such as an adhesive with a different bonded heat stress value than that of the adhesive in claim 1.

Inventions V and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as heating the adhesive components at a temperature above 250 °F.

Inventions II and III are related as independent inventions, each having a unique and separate means for establishing patentability. Invention II is directed to a method of sealing and/or forming, where as Invention III is directed toward a process of bonding two substrates. Because these inventions are distinct for the reasons given above and have acquired a separate

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status in the art because of their recognized divergent subject matter as shown by their separate classifications above, restriction for examination purposes as indicated is proper.

Inventions II and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as applying an adhesive to a substrate.

Inventions V and II are related as process of making and process of using. The inventions are distinct if either or both of the following can be shown: (1) that the process of making as claimed can be used to make other and materially different product from the product used or (2) that the product used in the process as claimed can be made by another and materially different process. In the instant case the process of making as claimed can be used to make other and materially different product from the product used. Applicant is referred to the paragraph that discusses Invention I and Invention V above, where examiner demonstrates that case the process of making as claimed can be used to make other and materially different product from the product used.

Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as

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claimed can be used to practice another and materially different process such as a method of forming and/or sealing.

Inventions V and III are related as process of making and process of using. The inventions are distinct if either or both of the following can be shown: (1) that the process of making as claimed can be used to make other and materially different product from the product used or (2) that the product used in the process as claimed can be made by another and materially different process. In the instant case the process of making as claimed can be used to make other and materially different product from the product used. Applicant is referred to the paragraph that discusses Invention I and Invention V above, where examiner demonstrates that case the process of making as claimed can be used to make other and materially different product from the product used.

Inventions V and IV are related as process of making and apparatus for using the product made. The inventions are distinct if it can be shown that either: (1) that the process can be used to make another and materially different product than that used in the apparatus or (2) that the apparatus as claimed can be used with another and materially different product from that made. Applicant is referred to the paragraph discussing Inventions I and IV above, where examiner demonstrates that the apparatus as claimed can be used with another and materially different product from that made.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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A telephone call was made to Cynthia Folke on August 23, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 10:00-7:30, Monday -Thursday, 10:00-6:30 Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CTS



TOM DUNN
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